

#14
3/6/03

PLANT PATENT APPLICATION

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE BOARD OF PATENT APPEALS AND INTERFERENCES

IN RE APPLICATION OF:

ATTORNEY'S DOCKET NUMBER

Wilhelm ELSNER

2384-001440

RECEIVED
TECH CENTER 1600/2900

03 FEB

PM 3:43

ENTITLED

RECEIVED

Variety of Geranium named 'Pendec'

MAR 03 2003

Commissioner for Patents
Washington, D.C. 20231

TECH CENTER 1600/2900

RECEIVED
TECH CENTER 1600/2900

03 FEB 24
PM 3:43

HAND DELIVERY CERTIFICATE

Date of Deposit February 24, 2003

I hereby certify that the following attached paper or fee

Request for Oral Hearing (1 p.);
Petition Under 37 C.F.R. §1.182 (3 pp.);
Reply Brief (10 pp.); and
Checks for \$280.00 and \$130.00

are being hand-delivered to the United States Patent and Trademark Office on the date indicated above and is addressed to the Commissioner for Patents, Washington, D.C. 20231.

SALVADOR GONZALES

(Typed or printed name of person delivering paper or fee)

SJG/JF.

(Signature of person delivering paper or fee)

#14
3/6/03

Plant Patent Application
Serial No. 09/664,247
Confirmation No. 4085
Attorney Docket No.: 2384-001440

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE BOARD OF PATENT APPEALS AND INTERFERENCES

Application No. 09/664,247

Filing Date: September 18, 2000

Appellant: ELSNER, WILHELM

Examiner - Susan B. McCormick

Art Unit 1661

RECEIVED
TECH CTR 1600/2000
03 FEB 24 PM 3:44

REPLY BRIEF

Commissioner for Patents
Washington, D.C., 20231

Sir:

This Reply Brief is in response to the Examiner's Answer dated January 14, 2003.

I. Factual Background

The above-identified plant patent application was filed with the United States Patent and Trademark Office for a variety of geranium named 'Pendec' on September 18, 2000. A variety of geranium named 'Pendec' was sold in Germany in July of 1998. An application for a Community Plant Variety Rights (hereinafter, "CPVR") Certificate/Plant Breeders Rights (hereinafter, "PBR") Certificate was filed with the Community Plant Variety Office (hereinafter, "CPVO") in Europe for 'Pendec' on September 3, 1997 and given the reference number 97/0950. On December 15, 1997, the CPVO Official Gazette published a listing of application EU 97/0950 (submitted with Amendment of October 3, 2001) with the following minimal information:

Pelargonium L'Herit. Ex Alt.

a: 97/0950
b: 03/09/97

a: 000849
b: 00449

pendec z-135

The application of EU 97/0950 did not mature into a CPVR certificate and was subsequently withdrawn from application on May 10, 1999.

Additionally, pursuant to Article 87(1) of Council Regulation (EC) No. 2100/94 27 July 1994 on community plant variety rights, only the names and addresses of the breeder and representative, taxon statement, and provisional denomination is available for public inspection until a CPVR certificate is granted. No botanical data on the variety is available until the certificate is granted. Hence, because the application EU 97/0950 never matured into a certificate, botanical information about 'Pendec' was never available for public inspection.

Claim 1 stands rejected under 35 U.S.C. § 102(b) for asserted anticipation by EU 97/0950 in view of a sale of a variety of geranium named 'Pendec' outside the United States in 1998.

II. The issue on Appeal in the present application is whether a non-enabling printed publication on a plant variety rises to the level of enabling prior art when the plant was sold outside the United States

The plant patent examining group has created a new position on prior art to plant patent applications that is counter to decades of examination. This position has no basis in fact or in law and is based in part on a false premise, namely, LeGrice did not deal with sale in a foreign country. This policy, if not reversed by the Board, will have the effect of essentially blocking United States plant patents on plant varieties discovered in foreign countries. It represents the ultimate disservice to the foreign breeder.

A plant variety discovered in a foreign country typically requires several years of testing in the foreign market before it is selected for introduction in the United States. It also needs field trialing in the United States to determine if it can grow in the varied climatic conditions of this country. During that time, an application for PBR may be filed in that country and the variety may be sold into the foreign market. Neither of those activities (an application for PBR on the variety or a sale of the variety outside the United States) have previously been considered enabling prior art.

The sale puts the variety in a public domain, but not the public domain which constitutes a statutory bar - it is not "in this country" as required by 35 U.S.C. § 102(b).

The effects of this examination policy of using the foreign sale of a variety to enable a printed publication on the variety are several and at least include the following:

- (1) Countless extent plant patents would be invalid.
- (2) Foreign plant breeders must rush to file United States patent applications, even before foreign testing is complete, on all potential varieties. This is a financial disaster where normally 10% or less of the varieties tested are ultimately introduced into the United States market.
- (3) Foreign-bred plants may never reach the United States because foreign plant breeders have no incentive (no protection) for their varieties subject to the present examination policy.

This Appeal was instigated to avoid these effects and to permit Applicant to protect his rights in the United States.

III. The board should follow the holding of *In re LeGrice* (a plant patent decision), not that of *In re Thomson* (a utility patent decision)

The arguments and issue presented by the Applicant in the plant patent examining group, not repeated herein, actually boil down to a basic question. Should the Board follow the precedent of *In re LeGrice*, 301 F.2d 929, 133 USPQ 365 (CCPA 1962). The answer is YES.

A. *LeGrice* answered the same question posed in this Appeal.

At issue in *LeGrice* was whether a printed publication regarding a plant variety, when interpreted in light of the knowledge possessed by plant breeders, is capable of placing that variety in the public domain to constitute a bar under 35 U.S.C. § 102(b).

In the present case, the Examiner has asserted that *LeGrice* is not controlling because it did not specifically address the issue of enablement of a printed publication on a plant variety by sale of that plant outside the United States. However, as detailed below, the appeal in *LeGrice* actually did address an issue of commercial availability of a plant outside the United States.

B. The *LeGrice* decision contains significant evidence of public distribution of the rose varieties.

The Appellant of *LeGrice*, (Mr. Edward Burton LeGrice) filed plant patent applications in the United States in 1958 on two rose varieties, Charming Maid and Duskey

Maiden. More than one year before the filing dates, both varieties were listed in the National Rose Society Annual of England and in catalogs. Those publications are compelling evidence of public use or sale of the varieties in England.

The Rose Annual of 1949 stated that Dusky Maiden, “raised and exhibited by E.B. LeGrice”, received “The Gold Medal Award”. *Id.* at 931, 133 USPQ at 368. An award-winning plant undoubtedly was exhibited to rose breeders and other skilled artisans. Certainly, Dusky Maiden was publicly used in England by 1949.

The Rose Annual of 1954 contained information on Charming Maid including listing the following: “Raiser and Distributor E.B. LeGrice, Note Walsham”. *Id.* at 932, USPQ at 368. According to the 1954 Rose Annual, Charming Maid was distributed by Mr. LeGrice. Distribution (via a sale or other public activity) of Charming Maid occurred in England more than one year before the United States filing date.

Both Dusky Maiden and Charming Maid were described and shown in catalogs with color photographs thereof establishing identity in appearance between the varieties in the catalogs and the varieties of the United States plant patent applications. *Id.* Presentations of the varieties in a catalog is also compelling evidence of their status of having been offered for sale in England.

Despite all this evidence of sale and/or public use of Dusky Maiden and Charming Maid by Mr. LeGrice in England, the appeals court did not specifically address any issue of such activity presumably because it occurred outside the United States.

C. The record of the appeal in *LeGrice* shows that the sale and/or public use of the two rose varieties was disposed by the Board.

There was no discussion about enablement of the printed publication based on public availability of the rose in the *LeGrice* decision reported by the CCPA because the issue of public availability of the roses outside the United States was disposed of in the lower decision at the Board of Appeals. *Application of Edward Burton LeGrice*, Decision of Board of Appeals, February 12, 1960 (attached hereto and hereinafter referred to as the “Board LeGrice Decision”).

In the appeal to the Board by Mr. LeGrice, the Board correctly recognized that the “use or sale of the plants in a foreign country would be irrelevant” to the issue of novelty. *Id.* at page 25. Moreover, the Board found evidence of foreign sale and/or public use of the rose varieties.

The publications indicated that the particular plants were on sale, and presumably also in public use, more than one year prior to the respective filing dates of the applications since appellant is indicated as 'raiser and distributor.' However this question is not in issue since the public use or sale must be in the United States in order to bar a patent and these events, as far as anything suggested by the record is concerned, took place in England. The single broad issue of the competency of a prior printed publication to bar a plant patent is presented.

Id. at page 22.

Hence, the *LeGrice* court had plenty of evidence of commercial availability of the rose varieties outside the United States, and the stated presumption was that the plant was in public use. It did not directly address those facts since they were irrelevant to the novelty of the plant under United States statutory law and had been properly dispensed with by the Board of Appeals.

D. A publication is incapable of placing a plant variety in the public domain.

The *LeGrice* court focused on whether the publications (the Rose Annuals or the catalogs), when interpreted in light of the knowledge possessed by plant breeders, placed the rose varieties in the public domain. Importantly, when the court looked to what constituted the knowledge possessed by plant breeders, it did not even consider the evidence of prior use and/or sale of the rose varieties. The Board had dismissed any relevance of that evidence to the issue of novelty of the rose varieties in the United States.

Instead, the standard applied by the *LeGrice* court for the enablement of a publication under 35 U.S.C. § 102(b) is whether "a skilled artisan could take its teachings in combination with his own knowledge of the particular art and be in possession of the invention". *LeGrice* at 936, 133 USPQ at 372. The "knowledge" for a skilled artisan was not -- and still is not -- the commercial activity of the breeder outside the United States.

The "knowledge" of the skilled plant breeder includes plant genetics. In 1962, the knowledge of plant genetics meant that publications (such as the Rose Annuals and catalogs) could not be relied upon as statutory bars under 35 U.S.C. § 102(b). The *LeGrice* court cautioned, however, that each case must be decided on its own facts and that future studies may add to "the knowledge of plant breeders so that they may *someday* secure possession of a plant invention by a description in a printed publication". *Id.* at 939, n. 7, 133 USPQ at 374, n. 7.

There can be no dispute; that “someday” has not yet arrived.

IV. *Ex parte Thomson* does not control the enablement of prior art in plant patent applications.

In *Ex parte Thomson*, 24 USPQ 2d 1618 (Bd. Pat. App. & Int. 1992), the applicant appealed the rejection for lack of novelty in a utility patent application claiming asexually reproduced plant and seeds thereof. At issue, as in *LeGrice*, was whether a skilled artisan would have had sufficient knowledge to make the invention (the plant) described in a publication.

The Board looked to the opportunity to buy the seeds outside the United States as being the wherewithal of the skilled plant grower to obtain the claimed invention. Without citing to precedent, the Board raised the foreign sale of the seeds from a nonstatutory bar to an enablement of the publication.

In other words, the foreign sale of seeds became a reference, a point of knowledge, for the skilled artisan.

A. Sale of patentable subject matter outside of the United States is not prior art and cannot be used to enable a reference under 35 U.S.C. § 102(b).

Relying on *Thomson*, the Examiner’s Answer asserts that a non-enabling publication listing a plant variety, combined with evidence of the sale of that variety outside the United States, is an appropriate anticipation rejection. The Examiner’s Answer also argues that the language in *In re Samour*, 571 F.2d 559, 562, 197 USPQ 4 (CCPA 1978), of “[w]hether the claimed subject matter was in possession of the public depends on whether a method of preparing the claimed subject matter would have been known by, or would have been obvious to, one of ordinary skill in the pertinent art.” means that any public information relating to the claimed invention becomes an additional reference to enable a reference.

However, as was noted in Appellant’s Appeal Brief, *Samour* stands for the premise that an additional written reference may be relied upon to show what the primary reference contains. The additional written reference may be relied upon to show that the information contained in the primary reference, by itself, is fully enabling to one skilled in the art. *Samour* does not stand for the premise that an additional reference may be used to supplement the primary reference when the primary reference alone is not fully enabling.

The Examiner's Answer also misinterprets *In re Donohue*, 766 F.2d 531, 226 USPQ 619 (Fed. Cir. 1985). The *Donohue* case stands for the proposition that additional written references may be used to show that the claimed subject matter was in the public's possession before application thereof for a patent. The public disclosure of a chemical compound and the public disclosure of the name and variety of an asexually reproduced plant are two distinct situations. As the *Donohue* court stated, “[i]t is elementary that an anticipation rejection requires a showing that each limitation of a claim must be found in a single reference, practice, or device.” *Id.* at 534, 226 USPQ at 621.

It is elementary chemistry to realize that the disclosure of a compound's formula is enough to anticipate the claimed chemical formula because that formula is indeed the entire invention. However, disclosure of the botanical name (and possibly a few other particulars) of a new and unanticipated asexually reproduced plant variety is not enough to anticipate a plant patent for the claimed variety. As in *Samour*, the *Donohue* court agreed that a secondary piece of prior art (a written publication) could be used to show that knowledge was in the public's possession. In both cases, the secondary references (printed publications) provided information on the state of the art in the chemical field.

The Examiner's Answer on one hand asserts that the sale of a variety named 'Pendec' in Germany is not used as "supplementing" reference yet on the other hand supports the position for looking to the sale in Germany to enable the CPVO publication by relying on *Samour* and *Donohue*. Both cases allowed an additional piece of prior art (a pre-application filing date publication) as evidence of what knowledge was in the public domain.

However, it is contrary to longstanding tenets of the patent laws to assert that sale of a claimed invention outside of the United States qualifies as a reference at all. The sale of a variety named 'Pendec' outside the United States is not prior art. It is not a reference which is appropriate to use as evidence of the public's knowledge. An assertion that the sale of a claimed invention outside the United States is a reference (per *Samour* and *Donohue*) would vitiate the meaning of the on-sale bar of 35 U.S.C. § 102(b).

If the Board agrees with Examiner, it would be changing the landscape of the patent law. Applicant appreciates the Examiner's recognition that the PBR publication by itself would not be an enabled publication. In essence, the Examiner is asserting that a non-enabling published description of a claimed invention combined with the sale of that invention outside of the United States would be enough to satisfy an anticipation rejection under 35 USC § 102(b).

Such a position is untenable under United States law. By way of example, a simple (non-enabling) listing of a product (such as a computer) in a catalog or magazine published one year before an application for patent in the United States combined with the sale of that product outside the United States more than one year before application date would be enough to bar patent protection in our country. Such an assertion is ludicrous and the ramifications are endless if the Board chooses to change precedent and decide that the cited PBR application combined with the sale of a geranium named 'Pendec' in Germany would be enough to bar patent protection in the United States.

B. Even if *Thomson* is good law for utility applications, it is distinguishable from the present case.

The Board in *Thomson* chose to not follow *LeGrice* for the following reasons (however errant):

- (1) Per *LeGrice*, each case is decided on its own facts. Supposedly, in the day of *Thomson* in 1992, unlike in the day of *LeGrice*, the "someday" of plant genetics had arrived.
- (2) *LeGrice* lacked evidence of commercial availability of the claimed invention outside the United States.
- (3) *LeGrice* concerned a plant patent while *Thomson* dealt with a utility patent with broader scope of protection.

The first point fails because the "someday" of plant genetics is not here; see the Declaration of Dr. Richard Craig where he concludes that "Starting only from a photograph or a written description of a particular cultivar, a plant breeder cannot reproduce the cultivar. No person can independently create through fertilization and hybridization the exact genetic replica of another plant." Craig Declaration at page 4. The Examiner admits the same, else the PBR application would alone be cited as barring a plant patent. However, a key part of the first point is that these cases (*LeGrice* and *Thomson*) are decided on their own facts.

The second point fails because the Board misunderstood the evidence of commercial availability of the rose varieties in *LeGrice* by stating that:

[*LeGrice's*] holding was based on the specific "printed publications" before it, and no indication was given that the "prior catalogue publication" before it evidenced commercial availability in a readily enabling form. The

court simply stated that the prior catalog publication "includes a color picture of the rose clear enough to establish identity in appearance between the rose illustrated and applicants variety".

Thomson, 24 USPQ2d at 1621.

As detailed above, the *LeGrice* decision is replete with evidence of public use and/or sale of the rose varieties outside the United States. The irrelevance of those activities was disposed of by the Board.

The third point simply cuts in favor of following *LeGrice*. The present case is factually very similar to *LeGrice* and, unlike the utility application appealed in *Thomson*, involved a plant patent application.

V. Conclusion

The "someday" of plant genetics from *LeGrice* has not arrived. A printed publication cannot bar patenting of a plant because a plant variety cannot be created from a description of the plant.

The only § 102(b) bar to plant patent applications is the sale, offer for sale, or public use of the plant itself within the United States. Likewise, the invention of a plant patent is the plant itself. A plant patent can have but one claim -- to the plant itself. Plant patent infringement requires proof that the infringing plant is an asexually reproduced progeny of the parent plant -- it requires access to the plant itself. *Imazio Nursery, Inc. v. Dania Greenhouses*, 69 F.3d 1560, 36 USPQ2d 1673 (Fed. Cir. 1995).

It follows that the plant itself must be present in the United States to bar novelty under §102(b). The asserted enablement of a printed publication by "non-prior art" (sale outside the United States) is an attempt to thwart the statutory requirement that the plant itself be present in the United States to bar a plant patent in light of today's understanding of plant genetics.

Applicant urges the Board to follow the established federal court precedent of *LeGrice* and reverse the novelty rejection in the present application.

Filed concurrently herewith is a Request for Oral Hearing and a Petition
Under 37 C.F.R. §1.182 for an expedited, joint oral hearing.

Respectfully submitted,

WEBB ZIESENHEIM LOGSDON
ORKIN & HANSON, P.C.

Date: February 24, 2003

By Russell D. Orkin

Russell D. Orkin
Registration No. 25,363
Attorney for Applicant
700 Koppers Building
436 Seventh Avenue
Pittsburgh, Pennsylvania 15219-1818
Telephone: 412-471-8815
Facsimile: 412-471-4094
E-mail: webblaw@webblaw.com

WEBB ZIESENHEIM LOGSDON ORKIN & HANSON, P.C.

700 KOPPERS BUILDING

436 SEVENTH AVENUE

PITTSBURGH, PA 15219-1818

TELEPHONE 412-471-8815

FAX 412-471-4094

E-MAIL webblaw@webblaw.com

PATENT, TRADEMARK & COPYRIGHT LAW

WILLIAM H. LOGSDON
RUSSELL D. ORKIN
DAVID C. HANSON
FREDERICK B. ZIESENHEIM
RICHARD L. BYRNE
KENT E. BALDAUF
BARBARA E. JOHNSON
PAUL M. REZNICK
JOHN W. MCILVAINE III
BLYNN L. SHIDELER
JULIE W. MEDER
LESTER N. FORTNEY
RANDALL A. NOTZEN
KENT E. BALDAUF, JR.
KIRK M. MILES

OF COUNSEL
DONALD C. LEPIANE

WILLIAM H. WEBB (1929-1997)

JAMES G. PORCELLI
CHRISTIAN E. SCHUSTER
THOMAS J. CLINTON
DEAN E. GEIBEL
NATHAN J. PREPELKA
JESSICA M. SCHROTH
J. MATTHEW PRITCHARD IV
DARRELL E. WILLIAMS
ALKA A. PATEL
PHILIP J. FORET
PATRICIA A. OLOSKY
ALEXANDER DETSCHELT
GWENDOLYN R. ACKER WOOD

February 24, 2003

RECEIVED

MAR 03 2003

PATENT AGENTS
GARY F. MATZ
JAMES J. BOSCO, JR.
KRISANNE SHIDELER

TECH CENTER 1600/2900

Mr. John J. Doll
Director
Technology Center 1600
U.S. Patent and Trademark Office
Washington, D.C. 20231

Re: Application Serial No. 09/664,247
Our File 2384-001440

Dear Mr. Doll:

I am having hand-delivered to your office the Reply Brief, the Petition Under 37 C.F.R. §1.182 and the Request for Oral Hearing in connection with the appeal of Application No. 09/664,247 relating to the plant patent §102(b) issue.

You have previously advised me that my office has one of the cases ready for appeal on the §102(b) issue and that you will assist in expediting a hearing in conjunction with two cases being handled by Ken Klarquist of Portland, Oregon. I have also been in touch with Ken and will coordinate with him in any way necessary.

Thank you for your assistance in this matter and I look forward to learning of the oral argument hearing date.

If there are any questions, please contact Julie Meder or me at the Webb Firm.

Very truly yours,

Russell D. Orkin

RDO/PO/dp
Enclosures

RECEIVED
TECH CENTER 1600/2900
03 FEB 24 PM 3:16

Board LeGrice Decision

22 APPLICATION OF EDWARD BURTON LEGRICE

28 Decision of Board of Appeals, February 12, 1960

The above identified applications involving the identical legal question are being considered simultaneously on appeal. Each is an application for a plant patent having the customary single formal claim which in each case is directed to an assertedly new variety of rose plant.

In each case descriptions of the plant have appeared in printed publications more than one year prior to the filing of the applications. These have appeared, for one case,

in The National Rose Society Annual of England
29 for 1949 and for the other case in The National Rose

Society Annual of England for 1954 (the applications were filed in 1958). Photocopies of pages of these Annals are of record. In each case there are also catalogues published more than one year prior to the dates of the respective applications. The catalogues have not been made available but are admitted, pages 24 and 23 of the respective briefs, to "add to the information in the Rose Annual a reproduction in color of a color photograph of the variety."

In a paper filed November 19, 1959 in Appeal No. 269-46 requesting consolidation of the two appeals, appellant conceded that "the publications are thoroughly adequate in each instance to identify the plant as the plant in the particular application." A similar statement appears on page 3 in each of the reply briefs.

It may be noted that the various publications were acknowledged by appellant in the oaths accompanying the applications.

The publications indicate that the particular plants were on sale, and presumably also in public use, more than one year prior to the respective filing dates of the applications since appellant is indicated as "raiser and distributor." However this question is not in issue since the public use or sale must be in the United States in order to bar a patent and these events, as far as anything suggested by the record is concerned, took place in England. The single broad issue of the competency of a prior printed publication to bar a plant patent is presented.

APPLICATION OF EDWARD BURTON LEGBICK

23

30 The examiner has rejected the claim in each case on the ground that the printed publications having effective dates more than one year prior to the filing dates of the instant applications constitute statutory bars to the grant of patents on the described varieties of rose plants. The applicable portion of 35 U. S. C. 102(b) reads:

"A person shall be entitled to a patent unless—
• • •

(b) the invention was . . . described in a printed publication in this or a foreign country . . . more than one year prior to the date of the application for patent in the United States, . . ."

The examiner held the above provision applicable to plant patents in view of Chapter 15—Plant Patents of the U. S. Code Title 35—Patents, which in section 161 states:

"The provisions of this title relating to patents for inventions shall apply to patents for plants, except as otherwise provided."

Appellant (bottom of page 13 of brief) recognizes that the plant patent act was "engrafted onto the existing patent laws" and their provisions, except for "greater liberality in the completeness of the disclosure," made applicable to plants. He states:

"There was no intent to change the meaning of the wording such as now included in the quoted paragraph 102 (b), as theretofore applied to patents on articles, machines, methods, and the like. There is no evidence that it was intended that these words were to be interpreted differently in connection with plants."

It is evident from the preceding that appellant does not challenge the point so vigorously stressed by the examiner, namely the applicability of 35 U. S. C. 102(b) to plant patents. The premise of this appeal is simply that a publication describing a plant cannot, no matter how

24

APPLICATION OF EDWARD BURTON LEGRICE

31 complete, enable anyone to practice the invention (produce the plant); consequently such publication can never bar a plant patent under 35 U. S. C. 102(b). This result is said to follow from a consideration of the standard applied in patents for inventions, namely that in order to defeat such patents the printed publication advanced as a bar must be sufficient to enable one skilled in the particular art concerned to practice the invention, i.e., to produce the final useful result; Wisconsin Alumni Research Foundation v. George A. Breron & Co., 30 USPQ 242, 85 F. (2d) 166, CCA 8 (1936); Dewey & Almy Chemical Co. v. Mimex Co., Inc., 52 USPQ 138, 124 F. (2d) 986, CCA 2 (1942); or knowledge of the article describing would teach a skillful mechanic some process of making it; Cohn v. Corset Co., 93 U. S. 366, 23 L. Ed. 907 (1876); *In re Schaefer*, 2 App. D. C. 1, 8 (1893). Since neither of these requirements is met by a published description of a plant it is contended such publication must by application of the same standard be held insufficient to bar the grant of a patent on the plant.

The examiner, while not seriously challenging the appellant's premise that a plant description cannot enable anyone to produce the plant (nor do we see any reason for questioning this premise), states that the language of the statute must be taken in its exact and unequivocal meaning otherwise the anomaly arises that plant publications must be totally ignored as printed publications. In fact, it would have the effect of wholly eliminating that particular provision from 35 U. S. C. 102(b) in the case of plant patents. The examiner further maintains that a prior description of

32 an existing plant adequate to identify the plant claimed would negative patentable novelty as not "a distinct and new variety" (35 U. S. C. 161).

As indicated by his reply brief the most that appellant would concede with respect to the effect of such publication is that it might constitute secondary evidence of the prior existence of the actual plant and sole thereof so as to constitute a statutory bar. He further suggests that this

APPLICATION OF EDWARD BURTON LEGGEEH

25

secondary evidence could almost be accepted with little or no corroboration because the chances of any fraud on the public are extremely remote. As has been stated the use or sale of the plants in a foreign country would be irrelevant.

Appellant contends it is absurd to hold that in one case (mechanical) a disclosure must be an enabling disclosure while in another (plant) it need not be. The examiner's "strict literal interpretation" above is (page 13 of brief) alleged to defeat the intent of the plant patent law which is to reward practical results and perpetuate the thing patented after expiration of the patent. Since no one could produce the plant from a written description it is alleged that this result can be assured only by grant of a patent which in turn would encourage the inventor to distribute the plant widely and thereby minimize the possibility of its loss or destruction. With respect to the remark concerning absurdity, it is no more absurd to use a disclosure which is not enabling as a bar than it is to grant a patent on such a disclosure; the disclosure in the specifications of these applications are admittedly just as unenabling as the disclosures of the publications as page 9 of the brief states that:

33 "The teaching in plant patent cases . . . cannot enable anyone, even the most skillful of plant breeders, to produce the particular plant."

Upon consideration of the issue here presented we have come to the conclusion that the examiner must be sustained. Concerning the alleged need for an enabling disclosure to constitute an anticipation, we direct attention to the fact that in the case of claims to an article (or compound), which a claim for a plant is admitted (page 8 of brief) to be most nearly like, disclosure of an operative method of making such article is not essential to constitute an anticipation. On this point we think appellant has misinterpreted the case law. *Cohn v. U. S. Corset Co., supra*, relied upon by appellant did not require in the reference a

teaching of how to make the article. The Court of Appeals of the District of Columbia in the later decision *In re Deaker*, 1911 C. D. 274, 162 O. G. 999, 36 App. D. C. 104, quoted *Cohn v. U. S. Corset Co.* as authority for the proposition that the inoperativeness of the reference procedure was immaterial to a consideration of the patentability of the article. A complete description of the article in the reference was held to be all that was required to defeat claims to such article. This ruling was followed in *In re Marden & Rentschler*, 18 CCPA 1119, 1931 C. D. 334, 409 O. G. 561, 48 F. (2d) 428, 8 USPQ 515, in an application involving claims for a ductile thorium wire.

That this principle remains controlling law will be evident from the more recent decisions. See for example *In re Attwood*, 45 CCPA 824, 1958 C. D. 204, 730 O. G. 790, 253 F. (2d) 234, 117 USPQ 184, involving claims to U-shaped metallic channel member as a concrete insert.

24 The Court of Customs & Patent Appeals there stated:

"... it is well settled that where the article claimed is disclosed in a prior patent, the claim may be rejected on that patent notwithstanding the fact that the process by which the patentee claimed the product could be produced is inoperative. *In re Marden and Rentschler*, 16 C. C. P. A. (Patents) 1119, 48 F. 2d 428, 8 U. S. Pat. Q. 515; *In re Von Bramer et al.*, 29 C. C. P. A. (Patents) 1018, 1024, 127 F. 2d 149, 53 USPQ 345. Clearly, appellant can stand in no better position where the patentee discloses no process for making the article claimed or where appellant can not discern from the patent disclosure how to construct the article as disclosed."

In *In re Crosley et al.*, 34 CCPA 882, 1947 C. D. 216, 600 O. G. 172, 159 F. (2d) 735, 72 USPQ 499, the same court stated:

"Furthermore, this court is committed to the doctrine that where a product is clearly disclosed in a

APPLICATION OF EDWARD BURTON LEORICE

27

publication, the operativeness of any of the processes by which it is claimed the product could be produced is immaterial, and that the disclosure of the composition is sufficient to anticipate a claim therefor."

The U. S. Court of Appeals, District of Columbia Circuit still follows the same rule. See for example Merck & Co., Inc. v. Marzall, 1952 C. D. 35, 661 O. G. 576, 197 F. (2d) 206, 93 USPQ 355, wherein this court stated:

"We are dealing solely with an application for a patent on the compound itself. Such an application must be denied if there has been any prior disclosure of the compound, even though no practical means for its isolation or manufacture was previously known. R. S. 4S66, 35 U. S. C. § 31; *Eastman Kodak Co. v. Coe*, 78 U. S. App. D. C. 403, 135 F. (2d) 536."

Since appellant has admitted that the reference publications in these cases adequately identify the claimed plants it follows from these holdings that the appealed claims were properly rejected regardless of the question of sufficiency of the reference disclosures as to how to produce the plants. The decisions demonstrate that there is no inconsistency in this instance between what properly constitutes a publication under 35 U. S. C. 102(b) in mechanical cases (patents for inventions) and the examiner's application of the references to the claims in the instant plant patent cases.

The decision of the examiner is affirmed.

AFFIRMED

L. P. McCANN)
Examiner-in-Chief)
)
P. J. FEDERICO) BOARD
Examiner-in-Chief) OF
) APPEALS
N. A. ASP)
Examiner-in-Chief)